

### **THE OFFICE ACTION**

In the Office Action issued on April 21, 2004, the Examiner rejected claims 1-10 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,539,254 to O'Connor et al. ("O'Connor") in view of U.S. Patent Application Publication 2002/0117279 to Wertz et al. ("Wertz").

### **REMARKS**

Applicants have carefully considered the Office Action issued on April 21, 2004. Applicants respectfully request reconsideration of the application in light of the following comments and the accompanying Inventor Declaration under 37 C.F.R. §1.131.

#### **A. Wertz is not a Valid Reference**

The Examiner rejected claims 1-10 under 35 U.S.C. §103(a) as being unpatentable over O'Connor in view of Wertz.

Wertz was filed on December 22, 2000. Thus, for prior art purposes, it has a reference date of December 22, 2000. Enclosed herewith is a Inventor Declaration under 37 C.F.R. §1.131 signed by Gerald Chip, one of the co-inventors of the present invention. Also enclosed is a redacted copy of an invention disclosure form (Exhibit A) submitted to the Omnova Solutions Corporate Law Department relating to the present invention. Mr. Chip declares that the dates redacted from Exhibit A are prior to the December 22, 2000 effective date of Wertz.

Exhibit A describes the presently claimed invention which comprises a stable aqueous binder composition containing a styrene/butadiene latex binder modified with a urea/formaldehyde resin and its use with polyester fiber mats. Manufacture of various working examples are provided showing the use of such binders made from Dynea UF resin 2023-30, which is a short stopped UF resin, and SB emulsion polymers in the use of polyester mat binders and improvements shown in hot dry elongation values over conventional binders.

Applicants submit that the information attached as Exhibit A clearly

demonstrates reduction to practice of the inventive binder composition and mats made from the same in this country at a date at least prior to December 22, 2000. Thus, Applicants further submit that Wertz is not a valid prior art reference for the present invention and that, without the benefit of such a reference, the Examiner's rejection based on a combination of O'Connor and Wertz must be withdrawn.

**CONCLUSION**

In view of the foregoing comments, Applicants submit that claims 1-10 are in condition for allowance. Applicants respectfully request early notification of such allowance. Should any issues remain unresolved, the Examiner is encouraged to contact the undersigned to attempt to resolve any such issues.

If any fee is due in conjunction with the filing of this response, Applicants authorize deduction of that fee from Deposit Account 06-0308.

Respectfully submitted,

**FAY, SHARPE, FAGAN,  
MINNICH & MCKEE, LLP**

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Enclosures (2): 37 C.F.R. §1.131 Declaration  
Exhibit A